REMARKS

This is responsive to the Non-Final Office Action mailed August 16, 2006. In that Office Action, claims 6-11 were rejected under 35 U.S.C. §102(b) as being anticipated by Golba, Jr., U.S. Patent No. 5,919,172 ("Golba, Jr."). Claims 6-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clark et al., PCT Publication No. WO 01/78590 A1 ("Clark") in view of Pyles, U.S. Patent No. 5,669,882 ("Pyles").

With this Response, claim 6 has been amended; and claims 15 and 16 added. Claims 6-16 are pending in the application and are presented for consideration and allowance.

35 U.S.C. §§102, 103 Rejections

With respect to the rejections of claims 6-11 as being anticipated by Golba, Jr., claim 6 has been amended to recite that a length of the elongated cannula body is greater than a length of the outer cannula. Support for this language is found, for example, at page 9, line 16 – page 10, line 2; and FIGS. 5-8. In contrast, the shield 40 of Golba, Jr. (analogized in the Office Action as being the claimed "outer cannula") has a length that is greater than a length of the tube 12 (viewed in the Office Action as being the claimed "elongated cannula body"). That is to say, the cannula body/tube 12 of Golba, Jr. does not have a length that is greater than a length of the outer cannula/shield 40, as otherwise reflected in FIG. 2 of Golba, Jr. Thus, it is respectfully submitted that amended claim 6 is not anticipated by Golba, Jr.

Notably, the Golba, Jr. construction whereby the outer cannula/shield 40 has a length that is greater than a length of the cannula body/tube 12 is required by Golba, Jr.. Namely, Golba, Jr. uses the shield 40 in conjunction with a sealed package 50 within which the needle 10 is stored. That is to say, Golba, Jr. employs the shield 40 to protect an entirety of the needle 10, including the tube 12, such that the shield 40 must have a length that is greater than that of the tube 12. Further, it is respectfully submitted that the hypodermic needle of Golba, Jr. is non-analogous to the bone biopsy system of the pending application. For at least these reasons, then, it is respectfully submitted that amended claim 6 is not made obvious by Golba, Jr.

Claims 7-11 depend from amended claim 6. Thus, for at least the reasons above, claims 7-11 are also allowable over Golba, Jr.

With respect to the rejections of claims 6-14 as being unpatentable over Clark in view of Pyles, it is respectfully submitted that Clark does not qualify as prior art to the pending application. In particular, Clark is a PCT publication, published on October 25, 2001. Thus, Clark has an effective §102(a) date of October 25, 2001. Pursuant to the concurrently-filed Declaration of John A. Krueger under 37 C.F.R. §1.131 ("Krueger Declaration"), the inventor of the pending application possessed the inventions described therein before October 25, 2001, and was reasonably diligent from a time prior to the October 25, 2001 effective date of Clark in reducing the invention to practice (actual and/or constructive). In particular, the Krueger Declaration establishes that the invention was conceived prior to October 25, 2001, and was actually reduced to practice prior to October 25, 2001 and/or was constructively reduced to practice with reasonable diligence. Consequently, it is respectfully submitted that Clark is not prior art to the pending application such that the rejections based on Clark should be withdrawn.

In light of the above, it is respectfully submitted that claims 6-14 are allowable over the cited art.

Newly added claim 15 depends from claim 6 and thus, for at least the reasons above, is allowable. In addition, claim 15 recites that an outer hub is connected to a proximal portion of the outer cannula, and an inner hub is connected to a proximal end of the elongated cannula body. Further, the hubs are configured to establish a substantially air tight seal upon assembly of the elongated cannula body within the outer cannula. Support for this language is found, for example, at page 11, lines 6-20. It is respectfully submitted that Golba, Jr. does not teach or suggest these limitations. In particular, the shield/outer cannula 40 does not include an outer hub, nor is an air tight relationship established between hubs of the shield/outer cannula 40 and the tube/cannula body 12. Pointedly, Golba, Jr. has no need for such a relationship as the shield/outer cannula 40 is simply a protective body used in packaging of the hypodermic needle 10. That is to say, the shield/outer cannula 40 is <u>not</u> employed during use of the needle 10, such that a requisite suggestion to incorporate an air tight seal between hub components does not

exist. Thus, it is respectfully submitted that newly presented claim 15 recites additionally allowable subject matter.

Newly presented claim 16 depends from amended claim 6 and thus, for at least the above reasons, is allowable. In addition, claim 16 recites that the outer cannula terminates at a beveled distal end. Support for this language is found, for example, at page 10, lines 6-13, as well as FIGS. 5-7. In contrast, the shield/outer cannula 40 of Golba, Jr. does not include a beveled distal end. Further, because the shield/outer cannula 40 of Golba, Jr. is not employed during use of the needle 10, Golba, Jr. has no need for such a construction. Rather, the shield/outer cannula 40 is merely used to protect the needle 10 when packaged; in fact, providing the shield/outer cannula 40 with a beveled and may render subsequent packaging problematic in that the beveled end may pierce through the packaging material. Thus, it is respectfully submitted that newly presented claim 16 recites additionally allowable subject matter.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 6-16 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 6-16 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

Any inquiry regarding this Amendment and Response should be directed to Michael Steffensmeier at Telephone No. (614) 757-7861, Facsimile No. (614) 757-2243. In addition, all correspondence should continue to be directed to the following address:

Kimberly Luna, Paralegal
ALLEGIANCE CORPORATION
1430 Waukegan Road
McGaw Park, IL 60085-6787

Respectfully submitted,

John Krueger,

By his attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2004
Facsimile: (612) 573-2005

Date: December 18, 2006
TAC:jmc

Timothy A. Czaja
Reg. No. 39,649

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 18th day of **December**, **2006**.

By: _____
Name: Timothy A. Czaja